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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,978	05/14/2001	Scott LeKuch	YOR920000702US3	9086

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EXAMINER

PITARO, RYAN F

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,978

Applicant(s)

LEKUCH ET AL.

Examiner

Ryan F Pitaro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-4,6-20 have been examined.

Response to Amendment

1. This communication is responsive to Amendment C, filed 2/07/2005.
2. Claims 1-4,6-20 are pending in this application. Claims 1,11,17, and 20 are independent claims. In the Amendment C, Claims 1-4,6-20 were amended. This action is made Final.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4,6-7,9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norwood ("Norwood", US Re34,476) in view of Austen ("Austen", Unleashing the Power of the Pen).

As per claim 1, Norwood teaches a computing system for incorporating physical paper input into a graphical user interface (GUI), said computing system comprising: a computing device input system that records a physical writing using an electronic pen (col.9, lines 60-65) and, responsive to a user input, that selects a region of said recorded physical writing (col.10, lines 55-58), a computing device that comprises said

GUI and a display screen, wherein said GUI presents on said display screen a windowing GUI with a paper metaphor with user selectable actions (col. 11, lines 34-44), and wherein said computing device further comprises an object creation manager device, that creates a visual object representation of said selected region of said recorded physical writing and displays a graphical element of said object representation on said display screen (col.11 , line 33) and an object support component of said GUI that supports use of said created object representation by said GUI so as to enable a user selection of at least one of said actions to perform said selected action for said graphical element (column 11, lines 34-44). Norwood fails to distinctly point out using an electronic pen to put handwriting on a physical paper. However, Austen teaches using an electronic pen to put handwriting on a physical paper (Page 2 lines 6-10). Therefore it would have been obvious to an artisan at the time of the invention to combine Norwood's system with the teaching Austen. Motivation to do so would have been to provide portability to the system by using paper.

As per claim 2, Norwood teaches the computing system wherein said object support component of said GUI supports said selected action of said created object representation as a clipboard element that can be pasted into an application (col.14, lines 22-25; col.15, lines 43-45).

As per claim 3, Norwood teaches the computing system wherein said object support component of said GUI supports said selected action as a reminder note (col.14, lines 44-45).

As per claim 4, Norwood teaches the computing system wherein said graphical element is displayed in a window of said GUI (Fig.9-10).

As per claim 6, Norwood teaches the computing system wherein said selected region is indicated by said user manipulating said electronic pen to define a region within said recorded physical writing (col.10, lines 55-58).

As per claim 7, Norwood teaches the computing system wherein said region is defined by one of circling said region of said physical writing or by tapping corner boundaries of said region (col.10, lines 55-58).

As per claim 9, Norwood teaches the computing system wherein another user input indicates a desired type of object representation to be created by said object creation manager device by selecting an item from a menu bar (col.21, lines 53-56; col.22, lines 44-46).

As per claim 10, Norwood teaches the computing system wherein said computing input device system is comprised of a digitizer input system, and wherein said electronic pen is embodied as a pen that emits a signal that is detectable by said digitizer input system (claim 1, lines 5-10).

Independent claims 11,17 and 20 are similar in scope to independent claim 1, and are therefore rejected under similar rationale.

Claim 12 is similar in scope to claim 7, and is therefore rejected under similar rationale.

As per claim 13, Norwood teaches the method wherein said another user input indicates a type of object representation to be created by said creating step (col.21, lines 53-56; col.22, lines 44-46).

As per claim 14, Norwood teaches the method wherein said type of object representation is selected from a menu bar by said other input with said electronic pen (col.21, lines 53-56, col.22, lines 44-46).

Claims 15-16 are similar in scope to claims 6-7 respectively, and are therefore rejected under similar rationale.

Claim 18 is similar in scope to claim 9, and is therefore rejected under similar rationale.

Claim 19 is similar in scope to claim 7, and is therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norwood ("Norwood", US Re34,476) and Austen ("Austen", Unleashing the Power of the Pen) in view of Lui et al ("Lui", US 6,552,719).

As per claim 8, Norwood-Austen does not disclose the computing system wherein said user indicates a desire to select a region of said physical writing by tapping

a menu bar. However, Lui teaches the selection of a region by tapping menu button (Column 16 lines 52-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Lui's teaching with Norwood's method as an alternative method to selecting a region of interest.

Response to Arguments

Applicant's arguments with respect to claims 1-4,6-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan F Pitaro whose telephone number is 571-272-

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4071. The examiner can normally be reached on 7:00am - 4:30pm Monday-Thursday, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan Pitaro
Art Unit 2174
Patent Examiner

RFP

Kristine Kincaid
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